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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,316	05/26/2000	Pierre Girard	100954-001	9687
23117	7590	11/02/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER

1774

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,316

Applicant(s)

GIRARD ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed September 28, 2005.
Claims 1 and 3-6 were amended and claims 2 and 7-8 were cancelled rendering claims 1 and 3-6 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (U.S. 6,465,086).

Kitamura teaches an ink jet recording material having two coatings, where the inner coat comprises silica (column 2, lines 23-31 and column 8, lines 19-30) and where the first and second coatings are formed on the surface (column 3, lines 17-65, column 6, lines 10-42 and column 7, lines 49-60). Kitamura discloses the coating layer can be formed by conventional coating means, including a gravure means (column 12, lines 22-26 and column 22, lines 20-22) where the support is a paper sheet (column 13, lines 41-50). Kitamura discloses the inner coat (underrecording layer) comprises silica and the

Art Unit: 1774

surface coat (upperrecording layer) comprising kaolin or calcium carbonate (column 8, lines 21-30). Kitamura further discloses the invention being of conventional coated paper sheets (column 8, lines 5-18 and column 20, line 22) where paper sheets conventionally comprise fibrous materials. The reference discloses drying the coated paper (column 13, lines 20-33 and column 25, lines 20-27) and calendering the material (column 25, lines 28-32). Kitamura does not explicitly disclose that the cited inner coat has the deposition amount as instantly claimed. Such deposition amount is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the deposition amount, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. deposition amount) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the mechanical strength and durability of the coated paper. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the coated paper with the limitations of the deposition amount of the inner coat since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). In claims 1 and 4, Applicant amends the claims to include "which conventional surface coat includes a pigment component consisting essentially of kaolin and/or calcium carbonate." For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics

Art Unit: 1774

actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256.

Response to Arguments

4. The rejection made under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) is withdrawn due to Applicant amending claim 3 to further limit claim 1 to "from one gram to three grams per square meter (1 to 3 g/m²)."

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Werkema et al. (U.S. 4,575,477) is withdrawn due to Applicant removing precipitated calcium carbonate from claims 1 and 4.

Applicant's arguments regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (U.S. 6,465,086) have been considered but are unpersuasive. Applicant argues the composition of the inner coat includes a single pigment of silica and the conventional surface coat consists essentially of kaolin and/or calcium carbonate as a pigment, which excludes silica as a pigment in such a coat.

Art Unit: 1774

Kitamura discloses the inner coat (underrecording layer) comprises silica and the surface coat (upperrecording layer) comprising kaolin or calcium carbonate (column 8, lines 21-30). In claims 1 and 4, Applicant amends the claims to include "which conventional surface coat includes a pigment component consisting essentially of kaolin and/or calcium carbonate." For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

Art Unit: 1774

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 10/20/05